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to the first curve, and an insulating collar distal to the first curve, and the at least one active electrode comprises a filament and a head having an apical spike and an equatorial cusp.

### REMARKS

#### 35 U.S.C. §112

The Office Action rejected claims 5-8, 11, 12, 33, 35-38, and 40-42 under 35 U.S.C. §112, 2<sup>nd</sup> paragraph. Applicant amends claims 5, 7, 8, 11, and 42 herein.

Regarding claim 33, the Office Action states that "the ablating step should be performed with the electrodes." Applicant disagrees with this rejection. Applicant is entitled to claim the invention in any manner permitted by 35 U.S.C.

Applicant refers to M.P.E.P. §2171 and §2172 which state the proper criteria for a rejection under 35 U.S.C. §112, 2<sup>nd</sup> paragraph for failure of the applicant to point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action fails to provide any evidence (apart from the specification) showing that claim 33 does not correspond in scope with that which the applicant regards as the invention. Such a showing is required by the above cited M.P.E.P. sections. Merely stating that an applicant fails to claim the subject matter which applicant regarded as the invention and stating that a claim "should" be further limited is improper.

Based on the above, applicant believes that the above rejections based upon claims 5, 7, 8, 11, and 42 are overcome. The rejection based upon claim 33 should be withdrawn.

#### 35 U.S.C. §102

The Office Action rejected claims 1-4, 9-12, 14, 20, 21, 28-31, 33-38, 40, 41, 43, 47-49, 52, 55, and 57 are rejected under 35 U.S.C. §102(e) as being

anticipated by Underwood et al. (6,277,112) Applicant disagree with the validity of this rejection.

As filed, the subject application properly claimed benefit under 35 U.S.C. §120 to U.S. Patent 6,277,112 to Underwood et al. (application number 09/026,851.) Applicant respectfully refers to M.P.E.P. §706.02(b) which provides that a rejection based on 35 U.S.C. 102(e) can be overcome by perfecting priority under 35 U.S.C. §120. Accordingly, a rejection based on 35 U.S.C. §102(e) using Underwood et al. is improper since the subject application already contains a claim for benefit under 35 U.S.C. §120 to Underwood et al.

35 U.S.C. §103

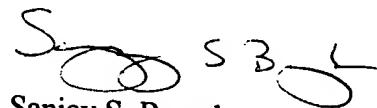
The Office Action rejected claims 50, 51, 53 and 56 under 35 U.S.C. §103(a) as being obvious over Underwood et al.

The subject application and U.S. Patent 6,277,112 to Underwood et al. were, at the time the invention of the subject application was made, owned by ArthroCare Corp. Accordingly, Underwood et al. is disqualified from being used in a rejection under 35 U.S.C. §103(a) against the claims of the subject application.

SUMMARY

Applicant believes all outstanding issue raised in the previous Office Action are addressed herein and that the claims are in condition for allowance. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at (408) 736-0224.

Respectfully submitted,



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the claims:

Marked-up versions of amended claims 5, 7, 8, 11, and 42 are provided below:

5. (amended) The method of claim 1, wherein said steps a) and b) result in formation of a channel within the nucleus pulposus, the channel having a channel wall, and the method further comprises:

d) positioning the at least one active electrode adjacent to the channel wall; and  
e) coagulating tissue of the nucleus pulposus by applying a second high frequency voltage between the at least one active electrode and the at least one return electrode [, ~~wherein the second high frequency voltage is adapted for coagulating tissue of the nucleus pulposus~~].

7. (amended) The method of claim 5, wherein the first high frequency voltage is in the range of from about 150 to about 700 volts rms, and the second high frequency voltage is in the range of from about 20 to about 150 volts rms.

8. (amended) The method of claim 5, wherein the first high frequency voltage is in the range of from about 150 to about 350 volts rms, and the second high frequency voltage is in the range of from about 20 to about 90 volts rms.

11. (amended) The method of claim 10, wherein said step [g)] f) comprises applying the electrically conductive fluid to the at least one active electrode, or applying the electrically conductive fluid to the disc.

42. (amended) The method of claim 33, wherein the shaft includes a shield, the shaft distal end portion includes a first curve, a second curve proximal to the first curve, and an insulating collar distal to the first curve, and the at least one active electrode comprises a filament and a head having an apical spike and an equatorial cusp.

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